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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,138	10/15/2003	Brian J. Brown	S13.12-0145	6236
38356 7590 04/16/2008 BROOKS, CAMERON & HUEBSCH, PLLC 1221 NICOLLET AVENUE, SUITE 500 MINNEAPOLIS, MN 55403				
EXAMINER TYSON, MELANIE RUANO				
ART UNIT 3773		PAPER NUMBER		
MAIL DATE 04/16/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,138

**Applicant(s)**

BROWN ET AL.

**Examiner**

Melanie Tyson

**Art Unit**

3773

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 12-19 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-19, and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 January 2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-9, 12-20, and 22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Election/Restrictions***

3. Applicant's election with traverse of Group I in the reply filed on 22 January 2008 is acknowledged. The traversal is on the ground(s) that it would not be a serious burden to search and examine the entire application. This is not found persuasive because the criteria for a proper requirement for restriction are as follows: (1) the inventions must be independent or distinct, and (2) there would be a serious burden if restriction were not required. Groups I and II are distinct in that the apparatus as claimed can be used to practice a materially different process (see restriction requirement for details). Furthermore, since the inventions have acquired a separate status in the art in view of their different classification (see restriction requirement for details) there would be a serious burden on the examiner if restriction were not required.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 23 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-8, 13, 14, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Melzer et al. (6,280,385 B1). Melzer discloses a stent (see entire document) comprising structural material substantially invisible under MRI visualization (for example, plastic) that forms a generally tubular structure having a plurality of cells (for example, see Figure 1), and a RF marker (2) that forms generally concentric loops on only one side (for example, only the outside), or on only the peripheral surface of the structure that delineates a circumference (for example, only on the outside), of each of the cells (for example, see Figure 6) capable of generating RF energy under a magnetic field.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2, 3, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melzer et al. in view of Doran et al. (2002/0055770 A1). Melzer fails to disclose the cells are interconnected to additional cells by connectors of the materials claimed.

Doran discloses a stent (see entire document) comprising cells. Doran teaches the cells are interconnected by connectors in order to increase flexibility of the stent (for example, see paragraph 83). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct Melzer's stent with connectors as taught by Doran. Furthermore, Doran teaches the stent and connectors may be made from materials such as ceramics, polymers, and combinations thereof (for example, see paragraph 187). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the struts of ceramic material and the connectors of a polymer material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

10. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melzer et al. in view of Case et al. (2004/0167619 A1). Melzer fails to disclose the RF marker is embedded in the structural material of the stent. Case discloses an expandable prosthesis (see entire document) comprising markers. Case teaches the markers may be embedded in the device (paragraph 42). It is well within the general knowledge of one having ordinary skill in the art to use a known technique to improve similar devices in the same way. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made embed the RF marker in Melzer's stent as taught by Case. Doing so would ensure the marker does not shift, or stays in the correct position on the stent during deployment.

11. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melzer et al. in view of Jackson et al. Melzer fails to disclose a magnetic susceptibility marker connected to the generally tubular structure. Jackson discloses a tubular structure (Figure 3). Jackson teaches connecting magnetic susceptibility markers (such as paramagnetic materials; paragraph 16) that are visible under MRI to the tubular structure. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct Melzer's stent with a magnetic susceptibility marker as taught by Jackson et al. in order to clearly recognize the position of the device under MRI (for example, see paragraph 16), thus facilitating proper implantation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-

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9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./  
Examiner, Art Unit 3773  
April 11, 2008

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773